

### REMARKS

Claims 16-31 remain in this application. Claims 16 and 25-27 were amended in this response to address claim objections raised by the Examiner. No new matter has been introduced as a result of the amendments.

In light of the above amendments, Applicant submits that the objections to claims 25-26 and 28-31 have been overcome. Withdrawal of the objections is respectfully requested.

Claims 16, 17, 21, 25 and 28 were rejected under 35 U.S.C. §102(b) as being anticipated by *Pequet*. (EP 0 689 303 A1).

Claims 18, 19, 22 and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Pequet*. (EP 0 689 303 A1) in view of *Haartsen* (US Patent No. 6,028,853).

Claims 20, 23, 26, 29 and 30 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Pequet*. (EP 0 689 303 A1) in view of *Threadgill et al.* (US Patent No. 6,185,409).

Claim 24 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Pequet*. (EP 0 689 303 A1) in view of *Haartsen* (US Patent No. 6,028,853), and further in view of *Threadgill et al.* (US Patent No. 6,185,409). Claim 24 was also rejected under 35 U.S.C. §103(a) as being unpatentable over *Pequet*. (EP 0 689 303 A1) in view of *Haartsen* (US Patent No. 6,028,853), and further in view of *Sicher et al.* (US Patent No. 6,385,195).

Claim 27 was rejected under 35 U.S.C. §103(a) as being unpatentable over *Pequet*. (EP 0 689 303 A1) in view of *Mauney et al.* (US Patent No. 6,484,027).

Claims 20, 23, 26 and 29-31 were also rejected under 35 U.S.C. §103(a) as being unpatentable over *Pequet*. (EP 0 689 303 A1) in view of *Sicher et al.* (US Patent No. 6,385,195). Applicant traverses these rejections. Favorable reconsideration is respectfully requested.

Specifically, none of the cited art, alone or in combination, teaches “additional transmission and switching means in the radio network terminating units for implementing at least one further communication network, wherein the additional transmission and switching

means provide for implementing additional wireless communication relations between the radio network terminating units” as recited in claim 16.

Pequet discloses a TDMA radio communication system wherein a base station, in an i-th time slot, transmits data to a first mobile station M1 with a first frequency FDL according to a TDMA protocol. The first mobile station M1 transmits data, in a k-th time slot, to a second mobile station M2 with the assistance of a second frequency FDM according to the TDMA protocol (see Abstract). The first mobile station M1 uses exactly one receiver on the basis of which the data of the i-th time slot and the data of the k-th time slot are transmitted with different frequencies according to the TDMA standard (see column 1, lines 50 to 55). The first mobile station M1 is synchronized with the base station BS and transmits its synchronization information to other mobile stations and also to the second mobile station M2. Under this method of operation, the coverage area is virtually expanded from the perspective of the base station BS (see column 2, lines 7 to 16). Using the forwarded bits of synchronization information, the first mobile station is only used as a relay under the teaching of Pequet (see column 2, lines 21 to 30 and column 3, lines 6 to 17).

As a result of this forwarding of the bits of synchronization information the respective mobile stations M2, M3 and M4 are also synchronized with respect to the base station BS (see column 2, lines 45 to 50 and column 4, lines 32 to 55, in particular). The first mobile station M1 is synchronized with respect to the base station by using the TDMA standard (see column 4, lines 1 to 5). Thus, Pequet transmits data between mobile stations and a base station on the basis of a prescribed standard (TDMA) whereby the synchronization itself always occurs by the base station. This makes it possible for the mobile stations to use exactly one receiver and to forgo a transmission of bits of synchronization information which are formed by the mobile station and which are formed independently of the used TDMA standard. This is explicitly disclosed in Pequet in column 5, lines 1 to 5 and lines 28 to 35, as well as column 6, lines 42 to 57. Furthermore the base station executes switching functions in order to be able to drive or address the second mobile station M2 via the first mobile station M1. Accordingly, the network administration is still controlled by the communication network.

In contrast, the present invention provides additional “transmission and switching means” for the network terminating devices so that a further communication network can be set up

between the network terminating devices. Using the switching means claimed in the present application, it is possible to operate a further communication network independently of the first communication network (see pages 7 and 7a of the original specification). In other words, the switching means provides relief to the first communication network since further data transmissions between the network terminating devices are carried out in a second independent communication network (i.e., "further communication network"). The switching functions, can now be incorporated into the network terminating devices as a component of the network intelligence (see specification on page 3). This is materially different from what is disclosed in the prior art, and more specifically to the disclosure in Pequet, which only allows the use of a single TDMA air interface. Accordingly, Applicant submits that the rejections under 35 U.S.C. §102 are improper, and should be withdrawn. Also, since Pequet does not teach the features discussed above, the rejection under 35 U.S.C. §103 is also improper and should be withdrawn.

Moreover, the teachings in the *Haartsen*, *Threadgill*, *Sicher* and *Mauney* references do not cure the deficiencies of Pequet, discussed above. Furthermore, the Office action improperly combined the aforementioned references and relied on impermissible hindsight in formulating the rejection. There is no teaching or suggestion for one of ordinary skill in the art to combine the teaching of Pequet with that of *Haartsen*, *Threadgill*, *Sicher* or *Mauney* in the manner suggested by the Examiner. For example, *Haartsen* discloses synchronization via ad hoc networks, where the synchronization locks to the strongest beacon signal emitted from a plurality of transceivers (col. 9, lines 3-30). *Threadgill* is directed to satellite communication, and *Mauney* is directed to a specialized handset that operates independently of the wireless network (see Abstract). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the examiner to explain

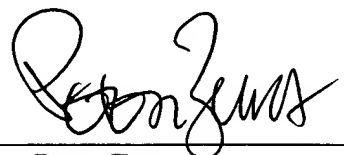
why the combination of the teachings is proper. *Ex parte Skinner*, 2 USPQ2d 1788 (Bd. Pat. App. & Inter. 1986). (see MPEP 2142).

Further, the Federal Circuit has held that it is "impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention" *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that "obvious to try" is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). "An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued." *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In light of the above amendments and arguments, Applicants submit that claims 16-31 are allowable. Applicants respectfully submit that the patent application is in condition for allowance and request a Notice of Allowance be issued. The Commissioner is authorized to charge and credit Deposit Account No. 02-1818 for any additional fees associated with the submission of this Response. Please reference docket number 112740-145.

Respectfully submitted,  
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